

REMARKS

Reconsideration of the objection and the rejections set forth in the Office Action dated September 13, 2005, is respectfully requested. The Examiner rejected claims 83-110. Applicants have amended claims 83, 85, 92, 94, 96, 97, and 100-102. Accordingly, claims 83-110 remain pending in the application. No new matter has been added by these amendments as can be confirmed by the Examiner.

A. The Claim Amendments Are Not Made for Substantial Reasons Related to Patentability

In the Office Action, the Examiner objected to claim 92, noting a typographical error in the claim, and rejected claim 94 under 35 U.S.C. § 112, ¶ 2 as allegedly being indefinite. Applicants appreciate the Examiner's careful examination of the present application and have made appropriate amendments to the pending claims. The claim amendments were made merely to correct minor typographical errors and to more clearly recite the claimed subject matter. Therefore, the claim amendments have not been made for substantial reasons related to patentability.

B. The Pending Claims Are Fully Supported by the Original Specification.

The Examiner also rejected claims 93-95 and 99-102 under 35 U.S.C. § 112, ¶ 1 as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

According to the Examiner, the added material includes "said key generation system generates a second unique data identifier for the source file" and "said database system deletes said [first] unique data identifier and the [first] source elements." Other allegedly added material include system operation and method steps subsequent to the generation of the second unique data identifier, such as "said source

print generation system extracts a second predetermined number of second source elements from the source file in accordance with said second unique data identifier" and "said database system associates said second unique data identifier and the second source elements with the source file."

This claimed subject matter clearly is fully supported in the specification as originally filed and is set forth in such a way as to reasonably convey to one skilled in the relevant art that Applicants had possession of the claimed invention at the time that the application was filed. For example, the original specification states "The key generator 22 resides on the data management server 20 and accepts input from a system manager for defining and generating a data identifier or key." (See specification at p. 8, lines 22-23.) The specification also discloses that "[i]t is to be understood that **keys can be added and removed at any time**, thus, the set of usable keys is not stagnant. The ability to change the set of keys that are used to create fingerprints of source files increases the security for the source file owners as it is more difficult for unscrupulous users of the source files to hide the unauthorized use of the source file." (See *id.* at p. 10, lines 14-18 (emphasis added).) The allegedly added material "said key generation system generates a second unique data identifier for the source file" and "said database system deletes said [first] unique data identifier and the [first] source elements" therefore are fully supported by the specification as filed.

Furthermore, once generated, the second unique data identifier is recited in the pending claims as being applied to the source file in substantially the same manner by which the first unique data identifier is claimed to be applied to the source file. Claim 93, for example, sets forth that "said source print generation system extracts a second predetermined number of second source elements from the source file in accordance with said second unique data identifier;" whereas, claim 83, as amended, recites " a source print generation system that extracts the first source elements from the source

file in accordance with said first unique data identifier." Likewise, claim 93 provides that "said database system associates said second unique data identifier and the second source elements with the source file," and amended claim 83 recites "a database system that stores the source file with the embedded information block, said first unique data identifier, the first source elements, and ownership information of the source file."

Accordingly, Applicants submit that the subject matter recited in claims 93-95 and 99-102 are fully supported by the original specification and respectfully request that the Examiner withdraw the claim rejections under 35 U.S.C. § 112, ¶ 1.

C. Rhoads Does Not Disclose or Suggest the Generation of a First Unique Data Identifier by Identifying a Predetermined Number of First Source Elements in the Source File as Recited in Amended Claims 83-110.

In the Office Action, the Examiner further rejected claims 83-93, 95-99, and 101-110 under 35 U.S.C. § 102(b) as allegedly being anticipated by Rhoads, United States Patent No. 5,768,426. Applicants respectfully submit, however that, by failing to disclose each and every element of independent claims 83 and 94, Rhoads neither anticipates nor renders obvious claims 83 and 94, as amended. Therefore, it is submitted that claims 83 and 96, as well as claims 84-95 and 97-110 that depend thereon, are in condition for allowance.

According to the Examiner, Rhoads' disclosure that "[t]he original image is encoded with a randomly generated 32-bit data word that is embedded in specific registration points of the image ... meets the limitation of a key generation system that generates a unique data identifier for the source file by identifying a predetermined number [sic, "of"] source elements in the source file." Rhoads actually discloses that the 32-bit identification word comprises a 4-bit field for a calibration sequence, a 16-bit field for a randomly-selected main identification number, an 8-bit field for a version number, and a 4-bit field for an error-checking value. (See Rhoads at col. 9, lines 18-38.) In fact, Rhoads does not teach or suggest that any of the disclosed fields is

determined by identifying a predetermined number of source elements in the source file as set forth in independent claims 83 and 94.

At least one recited element of claims 83 and 94 therefore is totally missing from Rhoads. In accordance with M.P.E.P. § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). The disclosure of a claim element in a prior art reference, when relied upon to negate patentability, must also be clear and unambiguous. Further, "[t]he identical invention must be shown in as complete detail as contained in the...claim." *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, and uniquely important in this case is the requirement that the elements relied on in the prior art reference must be arranged as required by the claim. See *In re Bonds*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Accordingly, Applicants submit that Rhoads fails to disclose each and every element of claims 83 and 94. Claims 83-110 therefore are not anticipated and are in condition for allowance.

D. Rhoads Does Not Disclose or Suggest the Extraction of the First Source Elements from the Source File in Accordance with the First Unique Data Identifier as Recited in Amended Claims 83-110.

The Examiner asserts that Rhoads' disclosure that "[t]he original image is encoded with a randomly generated 32-bit data word that is embedded in specific registration points of the image" also meets the limitation of "a source print generation system that extracts the source elements from the source file in accordance with said unique data identifier," relying on Rhoads at col. 9, line 32 - col. 10, line 27.

In the cited passage, Rhoads teaches the generation of one random encoding image for each bit in the 32-bit identification word. (See Rhoads at col. 9, lines 39-41.)

The encoding images are produced by scanning "a pure black image" thirty-two times; thereafter, each encoding image is spatially convolved. (See *id.* at col. 9, lines 41-46, 55-58.) The resultant random images, which have a '1' in their corresponding bit value of the 32-bit identification word, then are added together to form a composite embedded signal. (See *id.* at col. 10, lines 11-14.) To add the composite embedded signal to the original image, Rhoads discloses that iterative visual experimentation is required. (See *id.* at col. 10, lines 16-45.)

Claims 83 and 96, in contrast, recite the extraction of the source elements from the source file in accordance with the unique data identifier. Rather than producing encoding images by scanning "a pure black image" as disclosed by Rhoads, claims 83 and 96 set forth that the source elements are **extracted from the source file**. Rhoads further teaches that the scanned "pure black images" processed to form the composite embedded signal and that the composite embedded signal is **added to the original image**. Therefore, Rhoads also does not teach or suggest the extraction of source elements from the source file as set forth in independent claims 83 and 94.

Rhoads again fails to disclose each and every element of claims 83 and 94. Accordingly, Applicants submit that claims 83-110 are not anticipated and are in condition for allowance.

E. No Motivation Exists to Modify the Teachings of Rhoads in a Manner that Precludes the Patentability of Amended Claims 83-110 Under 35 U.S.C. § 103.

In accordance with M.P.E.P. § 2142, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met." (M.P.E.P. § 2143.) First, some suggestion or motivation in the prior art references or in the knowledge of one of ordinary skill in the relevant art must exist to modify or combine the references. Second, if the references are combined, a reasonable expectation of success must be shown. Then, finally, all of the claim limitations must be taught or suggested by one

reference or a combination of references. To establish a *prima facie* case of obviousness based on a single reference that does not teach all the elements of a claim, the Examiner must provide a rationale for modifying the teachings of the reference. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), citing, *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

In the manner discussed in more detail above, at least one recited element of claims 83-110 is totally missing from Rhoads. Further, the Examiner does not assert that any teaching or motivation exists in the prior art to modify Rhoads in a manner that renders claims 83-110 obvious. The Examiner therefore has not established a *prima facie* case under 35 U.S.C. § 103 because, as shown above, all of the elements of the pending claims are not found in the cited reference. Accordingly, Applicants respectfully submit that claims 83-110 are not rendered obvious by Rhoads and are in condition for allowance.

For at least the reasons set forth above, it is submitted that claims 83-110 are in condition for allowance. A Notice of Allowance is earnestly solicited. The Examiner is encouraged to contact the undersigned at (949) 567-6700 if there is any way to expedite the prosecution of the present application.

Respectfully submitted,

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